

### **REMARKS**

Applicant has received and carefully considered the Office Action. Claims 1-3, 5, 6, 8-10, 12, 13, 15, 17, 36, and 37 are pending. Claims 4, 7, 11, 14, 16, and 18-35 were previously cancelled without prejudice or disclaimer. Claims 1, 3, 12, 13, 17, and 37 are amended by this response. Support for the amendments may be found at least in Figures 3 and 4; page 7, line 22-page 8, line 25; page 11, line 4-page 12, line 14; page 13, line 25-page 14, line 6; and page 18, line 9-page 19, line 20 of the specification. No new matter has been added.

The Office Action (1) rejects claims 1-3, 5, 6, 8-10, 12, 13, 15, 17, 36, and 37 under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not enable a person skilled in the art to practice the invention commensurate in scope with these claims; (2) rejects claims 3 and 13 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention; (3) rejects claims 1-3, 5, 6, 8-10, 12, 13, 15, 17, 36 and 37 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter; (4) rejects claims 1, 2, 5, 6, 8, 12, 15, and 17 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,018,718 to Walker et al. ("Walker"); and (5) rejects claims 3, 9, 10, 13, 36, and 37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Walker in view of Official Notice.

Applicant appreciates the time and courtesy extended by Examiner Scott S. Trotter during a telephone interview on June 1, 2009. Applicant's representatives discussed proposed amendments and Applicant's position regarding how these claims are distinguishable over the cited references. Although no agreement was reached concerning the patentability of these amended claims, the Examiner indicated that the inclusion of such amended features would likely be appropriate to overcome the pending rejections.

In view of the above claims and following Remarks, Applicant respectfully requests reconsideration and timely withdrawal of the rejections for the reasons discussed below.

#### **Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 1-3, 5, 6, 8-10, 12, 13, 15, 17, 36, and 37 are rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not enable a person skilled in the art to practice the invention commensurate in scope with the claims. The Office Action states that "the specification, while being enabling for monitoring credit accounts, does not reasonably provide enablement for monitoring payment mechanisms such as cash." See Office Action at 4.

Although Applicant disagrees that the claims as written are not enabled by the specification, Applicant has amended independent claims 1 and 12 in an effort to more clearly recite the claimed features and advance prosecution. Specifically, the phrase “or payment mechanisms” has been removed from claims 1 and 12. Amended claims 1 and 12 recite “the dedicated use of the credit account comprising a predetermined level of usage of the credit account by the customer in relation to one or more other credit accounts associated with the customer.”

In view of the above, Applicant respectfully requests that the rejections be withdrawn.

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 3 and 13 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action states: “It is unclear what is meant by ‘exclusive use of the credit account.’ It brings up the question exclusive for what?” *See* Office Action at 5.

Although Applicant disagrees that claims 3 and 13 as written do not satisfy 35 U.S.C. § 112, second paragraph, Applicant has amended the claims in an effort to more clearly recite the claimed features and advance prosecution. Specifically, amended claims 3 and 13 recite that “the dedicated use of the credit account further comprises exclusive use of the credit account **rather than the one or more other credit accounts over the period of time.**”

In view of the above, Applicant respectfully requests that the rejections be withdrawn.

**Rejections Under 35 U.S.C. § 101**

Claims 1-3, 5, 6, 8-10, 12, 13, 15, 17, 36, and 37 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The Office Action states: “Claims 1-17, 36, and 37 are directed to a process. In order to be statutory a process must be either tied to another statutory class (such as a particular apparatus) or transform underlying subject matter (such as an article or materials) to a different state or thing. The only apparatus mentioned in the claims is a computer system which in the context of a ‘usage program’ could be interpreted to be software.” *See* Office Action at 5.

The Court of Appeals for the Federal Circuit held in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008), that the “definitive test” for whether a claimed process complies with 35 U.S.C. § 101 is the “machine-or-transformation” test where a “claimed process is surely patent-eligible under §

101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *Id.* at 954.

Although Applicant believes that the claims as written satisfy 35 U.S.C. § 101, Applicant has amended the claims in an effort to more clearly recite that the claimed features are at least tied to a particular machine or apparatus and therefore meet the “machine-or-transformation” test of *Bilski*. Independent claim 1 has been amended to recite “**using one or more computer processors**, monitoring over a period of time credit activity corresponding to the credit account and activity corresponding to the one or more other credit accounts to determine if the monitored credit activity satisfies the terms of dedicated use.” Independent claim 12 has been amended to recite “**using one or more computer processors**, associating the credit account with a usage program, the usage program comprising one or more terms of dedicated use, the terms of dedicated use associated with providing a benefit to the customer in return for dedicated use of the credit account, the dedicated use of the credit account comprising a predetermined level of usage of the credit account by the customer in relation to one or more other credit accounts associated with the customer.”

In view of the above, Applicant respectfully requests that the rejections be withdrawn.

**Rejections Under 35 U.S.C. § 102(b)**

Claims 1, 2, 5, 6, 8, 12, 15, and 17 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Walker.

Although Applicant believes that the currently pending claims sufficiently distinguish Walker and other references, Applicant has amended independent claims 1 and 12 in an effort to more clearly recite the claimed features and advance prosecution. Applicant reserves the right to file one or more continuation applications for unclaimed subject matter.

Specifically, claim 1 has been amended to recite “the dedicated use of the credit account comprising a predetermined level of usage of the credit account by the customer **in relation to one or more other credit accounts** associated with the customer,” “using one or more computer processors, monitoring over a period of time credit activity corresponding to the credit account **and activity corresponding to the one or more other credit accounts to determine if the monitored credit activity satisfies the terms of dedicated use**,” and “maintaining the benefit if the monitored credit activity satisfies the terms of dedicated use.” Applicant appreciates the Examiner’s indication that the “invention as gleaned from the specification seems likely to be

novel and nonobvious,” *see* Office Action at 3, and has amended claim 1 in these respects to advance prosecution.

Walker is directed to a system for “generating, communicating and managing a customized reward offer presented to an account holder.” *See* Walker, col. 1, lines 8-10. The disclosed system accesses historical credit card account data for an account holder and determines a “first performance target” and reward to be offered if the account holder meets the first performance target. *See* Walker, col. 4, lines 18-23. The account holder then completes transactions using the credit card account. *See* Walker, col. 4, lines 28-31. The system evaluates data for the account holder’s transactions, determines if the account holder met the first performance target, and sets a “second performance target” and reward offer based on the evaluated data. *See* Walker, col. 4, lines 40-56. In that way, the reward offers may be tailored to the particular account holder.

Walker discloses various types of “performance targets,” including “a target quarterly charge volume, a target quarterly outstanding balance, and a target number of transactions per month” and “target monthly principle payments, target annual purchases at specific merchants and target balance transfer amounts.” *See* Walker, col. 6, lines 22-29. However, none of the performance targets has anything to do with dedicated use of a credit account or a predetermined level of usage of a credit account “in relation to one or more other credit accounts associated with the customer.” Walker also has nothing to do with monitoring activity corresponding to the **one or more other credit accounts** to determine if monitored credit activity satisfies terms of dedicated use. Walker therefore fails to teach or suggest the features of amended independent claim 1.

Independent claim 12 has been similarly amended and is allowable for similar reasons. Claims 1, 2, 5, 6, 8, 12, 15, and 17, and all corresponding dependent claims, are therefore allowable for at least the reasons noted above.

### **Rejections Under 35 U.S.C. § 103**

Claims 3, 9, 10, 13, 36, and 37 are rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Walker in view of Official Notice. Claims 3, 9, 10, 13, 36, and 37, which depend from independent claims 1 and 12, are allowable for the reasons noted above. In addition, official notice is improper for each claim for the reasons stated in Applicant’s response of November 26, 2008.

Further, as to claims 3 and 13, the Office Action acknowledges that “Walker does not teach providing benefits for an exclusive creditor deal,” but takes official notice that “it is old and well known in the art of exclusive deals that a benefit must be given to receive an exclusive right and it is also well known to have liquidated damages clauses in such contracts to establish the proper level of damages for breach of the contract.” *See* Office Action at 10. The Office Action also states that “Wood v. Lady Gordon Duff Gordon 222 NY 88 or 118 NE 214 (1917) supports that a benefit must be given to receive an exclusive right.” *See* Office Action at 2. Official notice, however, may only be taken where the facts asserted to be well known are “capable of instant and unquestionable demonstration as being well-known.” MPEP § 2144.03. Claims 3 and 13 have been amended to recite that “the dedicated use of the credit account further comprises exclusive use of the credit account **rather than the one or more other credit accounts over the period of time.**” The reason why official notice is improper here is that the fact that a benefit may be given in exchange for an exclusive right does not mean that it would have been well known to provide a benefit to a customer according to terms of dedicated use, wherein dedicated use comprises exclusive use of a credit account **rather than** one or more other credit accounts over a period of time. Thus, official notice in the context of claims 3 and 13 is inappropriate.

As to claims 36 and 37, the Office Action acknowledges that Walker does not teach “maintaining a predetermined level of activity to maintain a benefit,” but takes official notice that “it is old and well known in the art of credit cards to deactivate credit card accounts based on inactivity. Which is monitoring an accounts usage level to see if meets a predetermined level and providing the benefit of access to the service if it is maintained.” *See* Office Action at 11. Claims 36 and 37, however, recite maintaining or providing a benefit if an account usage level is greater than or equal to a predetermined level of usage of a credit account by a customer **in relation to one or more other credit accounts associated with the customer.** The reason why official notice is improper here is that the fact that credit card accounts may be deactivated based on inactivity does not mean that it would have been well known to maintain or provide a benefit if an account usage level is greater than or equal to a predetermined level of usage of a credit account by a customer **in relation to** one or more other credit accounts associated with the customer. Official notice in the context of claims 36 and 37 is therefore inappropriate.

Claims 3, 9, 10, 13, 36, and 37, and all corresponding dependent claims, are therefore allowable for at least the reasons noted above.


**CONCLUSION**

For all the reasons set forth above, Applicant solicits allowance of all listed claims. In the event any outstanding issues remain in the Application, the Examiner is more than welcome to call the undersigned counsel to resolve any such issues in the interest of expediency and to further place the application in condition for allowance.

It is believed that all necessary fees are being charged for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicant also authorizes the Director to charge all required fees, fees under 37 C.F.R. § 1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,  
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By: \_\_\_\_\_



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